UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,239	01/04/2002	Edward Balassanian	3802-4058US1	8182

7590	12/14/2005

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EXAMINER
NAHAR, QAMRUN

ART UNIT	PAPER NUMBER
2191	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/039,239	BALASSANIAN, EDWARD
	Examiner	Art Unit	
	Qamrun Nahar	2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2005.*

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 September 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *1/16/03, 1/27/03*

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the amendment filed on 09/15/2005.

2.   The objection to the drawings is withdrawn in view of applicant's submission of

replacement sheets on 9/15/05.

3.   The objection to the specification is withdrawn in view of applicant's amendment filed

on 6/16/05.

4.   Claims 1-17 are pending and stand finally rejected.

Response to Arguments

5.   Applicant's arguments filed on 06/16/2005 have been fully considered but they are not

persuasive.

In the remarks, the applicant argues that:

a)   Applicant respectfully submits that the cited references do not disclose or suggest at least

the first claimed feature, as noted above. ... Srivastava and Ono, individually or in combination,

do not deal with the receipt of both code and specified characteristics from a developer; the

evaluation of such code (in an intermediate code form) to determine whether it satisfies the

developer's specified characteristic, and the notification to the developer of whether the

developer's code satisfies the developer's specified characteristics.

The remaining reference Megiddo relied upon by the Examiner does not remedy the

deficiencies of the Srivastava and Ono teachings. Megiddo describes an approach whereby a

request for submission of modules meeting particular requirements are posted, modules are

submitted by developers, these modules are tested from compliance with the requirements of the

requestor (not the developer who is submitting a module) and a module is selected.

Accordingly, the cited references individually or in combination simply do not disclose

or suggest the receipt of both code and specified characteristics from a developer and the

subsequent evaluation and notification with respect to the code and characteristics from the

developer.

Examiner's response:

a)   Examiner strongly disagrees with applicant's assertion that the combination of

Srivastava, Ono, and Megiddo fails to disclose the claimed limitations recited in claim 1. The

combination of Srivastava, Ono, and Megiddo clearly shows each and every limitation in claim

1.

As previously pointed out in the last Office Action, (Mailed on 12/16/2004, par. 7), and

currently maintained by the Examiner, Srivastava teaches receiving base code from a developer

(Abstract "program written ... source code" – The source code interpreted as base code received

from a developer.); furthermore, Ono teaches the developer code received is supplemented with

developer-specified characteristics (col. 2 lines 37-52 "software part suited to the specification is

retrieved"; col. 4 lines 21-28 "software part... Include... a program pattern representing a basic

means for realizing a predetermined function...", - Interpreted as developer-specified

characteristics used for determining col. 4 lines 58-60 "a program to be formed to satisfy the

specification"). Granted the applicant is emphasizing "the receipt of both code and specified

characteristics <u>from a developer</u>". Two references are relied upon for "the receipt of both code

and specified characteristics from a developer", which is permissible under 35 U.S.C. 103.

In response to applicant's arguments against the references individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). That is, Megiddo is relied upon

for the limitation, "the evaluation of such code (in an intermediate code form) to determine

whether it satisfies the developer's specified characteristic, and the notification to the developer

of whether the developer's code satisfies the developer's specified characteristics"; not Srivastava

or Ono. Furthermore, applicant has failed to specifically point out the error in the Examiner's

citation provided of Megiddo for these limitations.

In addition, see the rejection in the previous Office Action, Mailed on 12/16/2004,

paragraph 7 for rejection to claim 1.

In the remarks, the applicant argues that:

b)   Furthermore, absent impermissible hindsight, one of ordinary skill in the art would not

combine the cited references in the piecemeal manner suggested by the Examiner. The cited

references have nothing whatsoever to do with the evaluation of a developer's code according to

the developer's specified characteristics and subsequent notification to the developer of the

evaluation.

Examiner's response:

b)   In response to applicant's argument that the examiner's conclusion of obviousness is

based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the

time the claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392,

170 USPQ 209 (CCPA 1971).

In the remarks, the applicant argues that:

c)   In addition, the cited references do not disclose or suggest sending the target code to the

requester. Ono as relied upon by the Examiner simply describes an automatic program

synthesizer, and appears to be silent as to how a synthesized program is provided or made

available to others, such as a requester. See col. 1, lines 9-13. The Examiner asserts that it is

inherent that the target code is sent to the requester. Applicant disagrees. The fact that a certain

result or characteristic may occur or be present in the prior art is not sufficient to establish the

inherency of that result or characteristic. See MPEP 921 12 (citations omitted) (EXAMINER

MUST SHOW RATIONAL OR EVDENCE TENDING TO SHOW INHERENCY). To

establish a rejection based on inherency, the examiner must provide a basis in fact and/or

technical reasoning to reasonably support the determination that the allegedly inherent

characteristic necessarily flows from the teachings of the applied prior art. Id. A synthesized

program of Ono may be made accessible in ways other than sending to a requester. The Office

Action does not adequately set forth any fact or technical reasoning of how the claimed sending

necessarily flow from the automatic program synthesizer.

In view of the foregoing, claim 1 and its dependent claims are patentably distinguishable

over the cited references, individually or in combination. Reconsideration and withdrawal of the

rejection of these claims are respectfully requested.

Examiner's response:

c)   Examiner strongly disagrees with applicant's assertion that the combination of

Srivastava, Ono, and Megiddo fails to disclose the claimed limitations recited in claim 1. The

combination of Srivastava, Ono, and Megiddo clearly shows each and every limitation in claim

1.

As previously pointed out in the last Office Action, (Mailed on 12/16/2004, par. 7), and

currently maintained by the Examiner, Ono teaches receiving a request for target code from a

requester (col. 4 lines 29-39 "a function requested by a target system") ... sending the target code

to the requester (col. 1 lines 9-13 "synthesizing a program suitable for a target system" - It is

inherent the target code is sent to requestor. If a request has been received for target code from a

requester, then the target code will be sent to the requester after the target code has been

created.).

In addition, see the rejection in the previous Office Action, Mailed on 12/16/2004,

paragraph 7 for rejection to claim 1.

In the remarks, the applicant argues that:

d)   Claim 13 is directed ...

For similar reasons as discussed above for claim 1, the cited references, individually or in combination do not disclose or suggest the claimed receiving, evaluating and notifying of claim 13. Accordingly, claim 13 and its dependent claims are patentably distinguishable over the cited references, individually or in combination. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

Examiner's response:

d)   The Examiner has already addressed the applicant's arguments in the Examiner's Responses (a) thru (c) above. In addition, see the rejection in the previous Office Action, Mailed on 12/16/2004, paragraph 18 for rejection to claim 13.

In the remarks, the applicant argues that:

e)   Claim 15 is directed ...

As acknowledged by the Examiner, Srivastava does not disclose or suggest the claimed receiving, selecting, transforming or sending. Ono does not remedy these deficiencies in the Srivastava teaching. As discussed above, Ono describes ... As such, Ono does not disclose or suggest intermediate code from a collection of intermediate code is selected based on a requester's specified characteristics of the request, this selected code is transformed to target code according to the specified characteristics and the target code is sent to the requester.

In addition, as described above, Ono as relied upon by the Examiner simply describes an automatic program synthesizer, and appears to be silent as to how a synthesized program is

provided or made available to others. See col. 1, lines 9-13. The Examiner asserts that it is

inherent that the target code is sent to the requester. Applicant disagrees. ...

Accordingly, claim 15 and its dependent claims are patentably distinguishable over the

cited references, individually or in combination. Reconsideration and withdrawal of the rejection

of these claims are respectfully requested.

Examiner's response:

e)   The Examiner has already addressed the applicant's arguments in the Examiner's

Responses (a) thru (c) above. In addition, see the rejection in the previous Office Action, Mailed

on 12/16/2004, paragraph 20 for rejection to claim 15.

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

7.   Any inquiry concerning this communication from the examiner should be directed to

Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be

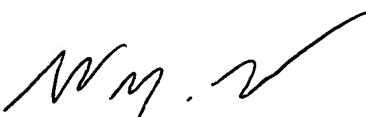reached on Mondays through Fridays from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Wei Y Zhen, can be reached on (571) 272-3708. The fax phone number for the

organization where this application or processing is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QN
November 30, 2005

WEI Y. ZHEN
PRIMARY EXAMINER